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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/520,079	08/28/1995	SHUNPEI YAMAZAKI	740756-1400	1321

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EXAMINER	
KIM, JAY C	

ART UNIT	PAPER NUMBER
2815	

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02/02/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.**	**Applicant(s)**
	08/520,079	YAMAZAKI ET AL.
	Examiner	**Art Unit**
	JAY C. KIM	2815

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 January 2012 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/J.K./	/JAY C KIM/ Primary Examiner, Art Unit 2815

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants argue that "the Office Action appears to rely on an unreasonably broad interpretation of the explicitly recited feature "a monodomain region which contains no grain boundary," and the interpretation is inconsistent with the plain teachings of the present specification". These arguments are not convincing for the following reasons. (1) Claims must be given their broadest reasonable interpretation. See MPEP 2111. Also, it is improper to import claim limitations from the specification. See MPEP 2111.01. (2) Applicants' arguments above appear to be based on importing claim limitations from the specification. (3) When Applicants claim only "a monodomain region which contains no grain boundary", the limitation can be reasonably interpreted to be "one domain region which does not contain a certain type of grain boundary" unless Applicants specifically define what the "monodomain" and/or "grain boundary" refer(s) to. (4) Fonash et al. in view of Sakamoto et al. do not comprise the grain boundaries shown in Fig. 2 of current Application, because the semiconductor islands of Fonash et al. in view of Sakamoto et al. are formed independently and separately.

Applicants argue that "also, the interpretation in the Office Action appears to be based on a reference, Takamura, which is not prior art with respect to the present application", that "initially, it is noted that Takamura is not prior art with respect to the present application", and that "as such, any discussion of Takemura with respect to the claims of the present application is inappropriate, and reconsideration of the rejection is requested for at least this reason". These arguments are not convincing for the following reasons. (1) Takemura was not used as a prior art reference. Rather, Takemura was used to show that there are grain boundaries that look different than the grain boundaries Applicants originally disclosed. (2) In other words, Takemura shows evidence that there are other types of grain boundaries than Applicants' disclosed grain boundaries, which is a natural phenomenon, which thus is not a patentable subject matter. (3) Therefore, Applicants cannot argue that Takemura cannot be used as a prior art reference, when the relevant teaching of Takamura is a natural phenomenon that Applicants cannot own or patent.

Applicants argue that "specifically, despite the use of similar processes, the present claims are explicitly directed to a domain "which contains no grain boundary"; whereas, Takemura teaches grain boundaries", and that "as such, there is no inconsistency". These arguments are not convincing because Takemura was used to show that there are other types of grain boundaries than disclosed by Applicants. Therefore, Applicants need to further limit "a monodomain which contains no grain boundary" to overcome the prior art rejection.

Applicants argue that "a semiconductor film as crystallized by the methods disclosed in the preferred embodiments of the present invention does include grain boundaries as disclosed in Takemura", that "that is, each of the monodomain regions 103, 104 and 105 does not have a grain boundary within the region", and that "therefore, it is respectfully submitted that there is no inconsistency between Takemura and the present invention". These arguments are not convincing because it is not clear how the straight-lined grain boundaries of Takemura can be the jagged grain boundaries of current Application. Rather, it appears that they are different types of grain boundaries.

Applicants argue that "it is respectfully submitted that those skilled in the art would recognize that a claim directed to "a monodomain region which contains no grain boundary" reads on the present specification including the examples discussed above", that "however, the Office Action appears to employ an interpretation that is not consistent with one that those skilled in the art would reach when reading the present specification in its entirety", that "specifically, in the pending rejections, it seems that the Office Action is attempting to ignore the term "grain boundary" or give an interpretation to the term "grain boundary" (e.g., in the manner set forth in the "Response to Arguments" section), which is entirely unreasonable and which appears to be based on an incorrect understanding of the present invention". These arguments are not convincing for the following reasons. (1) Applicants did not define specifically enough "a monodomain which contains no grain boundary". (2) As stated above, it is improper to import claim limitations from the specification. (3) Rather than the Examiner's interpretation of "grain boundary" being unreasonable, Applicants' recited "a monodomain which contains no grain boundary" is not specific enough, because there are at least two different types of grain boundaries, one shown in Takamura and another shown in current Application. (4) As stated above, Fonash et al. in view of Sakamoto et al. do not comprise the the grain boundaries shown in Fig. 2 of current Application, because the semiconductor islands of Fonash et al. in view of Sakamoto et al. are formed independently and separately.

The Examiner suggests that Applicants further limit "a monodomain region which contains no grain boundary", for example, "a monodomain region which contains no "closed" grain boundary". An amendment drawn to this limitation would likely overcome the rejection over the prior art of reference.